

### REMARKS

This amendment is responsive to the Office Action mailed November 17, 2004.

In the Office Action, claims 1, 3-5, 7, 9-24, 26-28, 30, 32-47, 49-51, 53, and 55-69 are rejected under 35 U.S.C. §103 as being unpatentable over Barnes & Noble in view of Hartman et al. Claims 1, 3-7, 9-24, 26-30, 32-47, 49-53, and 55-69 are currently pending.

### Priority Claim

It is respectfully submitted that the filing date of the present application is not February 28, 2002, which is the *publication* date of this application. This application was filed on April 10, 2001, and is a CIP of U.S. application Serial No. 09/645,460, filed August 24, 2000. Applicants, therefore, respectfully requests withdrawal of the Examiner's erroneous statement regarding the filing date of this application.

### 35 U.S.C. §103(a) Rejections

The Examiner acknowledges on page 4 of the outstanding Office Action that B&N does not teach the claimed second order processing route "affording the customer an opportunity to cause execution of the first and any additional purchase requests placed in the shopping card to be processed according to the express ordering processing that requires no further input by the customer to execute".

However, the Examiner contends that Hartman et al., U.S. Patent No. 5,960,411 teaches just such a step.

It is respectfully submitted that the Hartman et al. reference was the primary reference in the final Office Action mailed June 18, 2003, from which an appeal was previously filed in this case.

The Appeal Brief of December 3, 2004 was evidently effective to overcome this reference, as evidenced by the outstanding Office Action. Indeed, the shortcomings of this very same Hartman et al. reference have already been argued in great detail – and successfully. Indeed, the very elements acknowledged to be missing from the B&N primary reference have already been shown in the Appeal Brief to be missing from the Hartman et al. reference.

For completeness' sake, however, these arguments are repeated herein.

The Hartman et al. reference is relied on for a teaching of the claimed step:

responsive to receiving the first online request, providing a bifurcated order processing route that requests the customer to choose a first order processing route or a second order processing route,

the first order processing route causing the first online purchase request to be processed according to an express processing procedure that requires no further input by the customer to execute the first online purchase request,

the second order processing route causing the first online purchase request to be placed in a shopping cart that allows one or more additional purchase requests for additional items to be placed therein, the second order processing route affording the customer an opportunity to cause execution of the first and any additional purchase requests placed in the shopping card to be processed according to the express ordering processing that requires no further input by the customer to execute.

Aspects of the invention defined by independent claims 1, 24 and 47, are shown in Fig. 8 of the present application. Fig. 8, at step S83, incorporates Fig. 1 of the present invention. As shown, the claimed first order route of the claimed bifurcated order processing route includes the "YES" branch of step S82, whereas the claimed second order processing route includes the "NO" branch of step S82. The "NO" branch, as claimed, causes the first (and any subsequent) online purchase request to be placed in a shopping cart, as shown at S84, S85 and S86. As shown at S87, the second order processing route affords the customer the opportunity to cause execution of the first and any additional purchase requests placed in the shopping card to be processed according to the express ordering processing that requires no further input by the customer to execute. If the customer does not avail himself or herself with the claimed opportunity, the contents of the shopping cart are

checked out using a normal checkout procedure and the order is placed (sent to OFS), as shown at S88 and S89. The claimed bifurcated order-processing route is only disclosed in the present application and is not taught or suggested in the applied combination.

The Hartman et al. reference, either taken alone or in combination with the B&N reference does not teach or suggest a bifurcated order processing route, whereby customers are requested to choose a first or a second order processing route, in which the second order processing route affords the customer the opportunity to cause express ordering processing on their shopping cart, as claimed. The Hartman et al. reference (even when considered in combination with the B&N secondary reference, which the Examiner has already acknowledged does not teach this step) does not teach or suggest any mechanism by which customers are requested (as explicitly recited in claims 1, 24 and 47) to choose the a first or second order processing route, after which items placed in a shopping cart may be processed according to an express ordering processing that requires no further input by the customer to execute, again as required by the pending independent claims.

Hartman et al. discloses enabling a single action (usually, a single mouse click) ordering functionality. After selecting an item and single action ordering, the customer is given an opportunity to review change the single action order. Col. 5, lines 3-9. To help minimize shipping costs and purchaser confusion, the server system may combine various single-action orders. Col. 5, lines 26-28. Hartman et al.'s server system may also combine single action orders that are placed within a certain time period (e.g., 90 minutes). Orders placed may be combined or divided, based upon availability of the items ordered. Col. 4, lines 47-55, Col. 7, lines 24-56. Hartman et al. then teaches an algorithm for expedited order selection. The stated goal for this algorithm is to reduce the shipping costs. Col. 8, line 1 through Col. 9, line 7.

In the background section of this reference, Hartman et al. speaks of the drawbacks

inherent in the shopping cart model:

Although the shopping cart model is very flexible and intuitive, it has a downside in that it requires many interactions by the purchaser. For example, the purchaser selects the various items from the electronic catalog, and then indicates that the selection is complete. The purchaser is then presented with an order Web page that prompts the purchaser for the purchaser-specific order information to complete the order. That Web page may be prefilled with information that was provided by the purchaser when placing another order. The information is then validated by the server computer system, and the order is completed. Such an ordering model can be problematic for a couple of reasons. If a purchaser is ordering only one item, then the overhead of confirming the various steps of the ordering process and waiting for, viewing, and updating the purchaser-specific order information can be much more than the overhead of selecting the item itself. This overhead makes the purchase of a single item cumbersome. Also, with such an ordering model, each time an order is placed sensitive information is transmitted over the Internet. Each time the sensitive information is transmitted over the Internet, it is susceptible to being intercepted and decrypted." Col. 2, lines 26-48.

Thereafter, Hartman et al. makes it clear that the single-action ordering scheme disclosed therein is not related to the shopping cart model whose disadvantages are outlined in the background section. Indeed, specifically addressing the disadvantages of the shopping cart model outlined in the Background section, Hartman et al.'s claim 1 recites that the item ordered via the single-action model is *"ordered without using a shopping cart ordering model."* Hartman et al. claim 1, lines 35-36). In addition, Hartman et al.'s claim 11, at lines 28-30, recites *"...whereby the item is ordered independently of a shopping cart model and the order is fulfilled to complete a purchase of the item."*

Fig. 1A of Hartman et al. makes it abundantly clear, moreover, that the 1-click ordering scheme disclosed therein is designed for ordering an item - and not for processing the contents of a shopping cart. Indeed, the reference to 1-click in Hartman's Fig. 1A is grouped under the reference numeral 103, which relates to purchasing a single item, as opposed to reference numeral 102, which relates to the shopping cart model. See Col. 4, lines 4-33. There does not appear to be any teaching or suggestion in the Hartman et al. reference of applying the 1-click model to the

contents of a shopping cart. Such would be contrary to the claims in this patent, and would not address any of the disadvantages identified in the Background section thereof. It is to be noted that Hartman et al. is very specific as to the use of the disclosed single action or "1-click" ordering scheme: "This example single-action ordering section allows the purchaser to specify with a single click of a mouse button to order the described item." Col. 4, lines 31-33 (Emphasis Added). Hartman et al. pointedly does not state or suggest that the single action ordering section allows the purchaser to specify with a single click of a mouse button to order the items in the shopping cart - and explicitly teaches away from such a concept, for the reasons identified in Hartman et al.'s own Background section.

In direct contrast, the independent claims recite:

...the second order processing route affording the customer an opportunity to cause execution of the first and any additional purchase requests placed in the shopping card to be processed according to the express ordering processing that requires no further input by the customer to execute.

Recognizing the above-detailed shortcomings of the Hartman et al. reference, the Office has previously explicitly stated that the Hartman et al. reference fails to teach such claimed steps and features. Indeed, that the Hartman et al. reference does not teach the presently claimed second order processing route whereby the customer is afforded the opportunity to cause execution of the first and any additional purchase requests placed in the shopping cart to be processed according to the express ordering processing that requires no further input by the customer has been, in fact, acknowledged by the Examiner, at page 5, first full paragraph of the Office Action mailed June 18, 2003, which states: "*Hartman et al. does not disclose the automatic checking out of the shopping cart*". The Office Action continues and states: "However, Hartman et al. discloses that in some models when a purchaser selects any one item, then that item is "checked out" by automatically prompting the user for the billing and shipment information (col. 2, lines 24-47)." It is

respectfully submitted that checking out a shopping cart by prompting the user for billing and shipment information does not teach or suggest (whether considered singly or in combination with B&N) the claimed limitation of "...purchase requests placed in the shopping card to be processed according to the express ordering processing that requires no further input by the customer to execute", as claimed in the independent claims. How can Hartman et al. be said to teach processing a shopping cart according to the express ordering processing that requires no further input by the customer to execute, when Hartman et al. explicitly states that the customer must input billing and shipment information to process a shopping cart? The answer is that it cannot.

The Examiner is respectfully reminded that the foregoing arguments were sufficiently persuasive as to prompt the Examiner not to forward this appeal to the Board of Patent Appeals and Interferences, preferring instead to enter another non-final Office Action. Moreover, the Examiner has previously acknowledged in Office Action mailed June 18, 2003, that this very Hartman et al. reference does not teach the above claimed step. However, in the outstanding Office Action, the Hartman et al. reference again resurfaces (once acknowledged not to teach the claimed invention and once overcome on appeal) and is now asserted to teach the claimed bifurcated route, in contradiction to the Office's own past position on this issue and this reference and in contradiction to the Office's own actions in not forwarding the Appeal Brief to the Board of Patent Appeals and Interferences. It is respectfully submitted that the 35 U.S.C. §103 rejections of the independent claims are untenable and should be withdrawn.

It is, therefore, respectfully submitted that the present application is in condition for allowance, and an early indication of the same is respectfully requested. If any unresolved issues remain, please contact the undersigned attorney of record at the telephone number indicated below and whatever is necessary to resolve such issues will be done at once.

Respectfully submitted,

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By: 

Alan W. Young  
Attorney for Applicants  
Registration No. 37,970

Young Law Firm, P.C.  
4370 Alpine Rd., Ste. 106  
Portola Valley, CA 94028  
Tel.: (650) 851-7210  
Fax: (650) 851-7232

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